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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/627,085

07/24/2003

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42P6485C

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06/10/2010

INTEL/BSTZ

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EXAMINER

SCHNURR, JOHN R

ART UNIT

PAPER NUMBER

2421

MAIL DATE

DELIVERY MODE

06/10/2010

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.



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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/627,085
Filing Date: July 24, 2003
Appellant(s): WILLIAMS ET AL.

Gordon Lindeen
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 03/17/2010 appealing from the Office action mailed 09/25/2009.

(1) Real Party in Interest

The examiner has no comment on the statement, or lack of statement, identifying by name the real party in interest in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The following is a list of claims that are rejected and pending in the application:

Claims 1-33

(4) Status of Amendments After Final

The examiner has no comment on the appellant's statement of the status of amendments after final rejection contained in the brief.

(5) Summary of Claimed Subject Matter

The examiner has no comment on the summary of claimed subject matter contained in the brief.

(6) Grounds of Rejection to be Reviewed on Appeal

The examiner has no comment on the appellant's statement of the grounds of rejection to be reviewed on appeal. Every ground of rejection set forth in the Office action from which the appeal is taken (as modified by any advisory actions) is being maintained by the examiner except for the grounds of rejection (if any) listed under the

subheading "WITHDRAWN REJECTIONS." New grounds of rejection (if any) are provided under the subheading "NEW GROUNDS OF REJECTION."

NEW GROUND(S) OF REJECTION

Claims 15-19 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claims require a "machine-readable medium." The broadest reasonable interpretation of a machine-readable tangible medium in light of the specification includes a signal per se. As a signal is transitory in nature this creates a non-statutory transitory embodiment of the invention. Please refer to the memorandum from David Kappos, dated 01/26/2010, entitled "Subject Matter Eligibility of Computer Readable Media."

(7) Claims Appendix

The examiner has no comment on the copy of the appealed claims contained in the Appendix to the appellant's brief.

(8) Evidence Relied Upon

7,185,355	Ellis et al.	2-2007
6,133,910	Stinebruner	10-2000

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-14 are rejected under 35 U.S.C. 101 as not falling within one of the four statutory categories of invention. While the claims recite a series of steps or acts to be performed, a statutory “process” under 35 U.S.C. 101 must (1) be tied to another statutory category (such as a particular apparatus), or (2) transform underlying subject matter (such as an article or material) to a different state or thing (Reference the May 15, 2008 memorandum issued by Deputy Commissioner for Patent Examining Policy, John J. Love, titled “Clarification of ‘Processes’ under 35 U.S.C. 101”). The instant claims neither transform underlying subject matter nor positively tie to another statutory category that accomplishes the claimed method steps, and therefore do not qualify as a statutory process. In this case the method of choosing a list is not tied to a particular apparatus as the method steps may be performed manually.

Claims 15-19 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claims require a “machine-readable tangible medium.” The broadest reasonable interpretation of a machine-readable medium in light of the specification includes a signal per se. As a signal is transitory in nature this creates a non-statutory transitory embodiment of the invention. Please refer to the memorandum from David Kappos, dated 01/26/2010, entitled “Subject Matter Eligibility of Computer Readable Media.”

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims **1-4, 6, 10-18, 20-25 and 30-32** are rejected under 35 U.S.C. 102(e) as being anticipated by **Ellis et al. (US Patent 7,185,355)**, herein Ellis.

Consider **claim 1**, Ellis clearly teaches a method of choosing a preferences list comprising:

receiving a user identification for a current user; **(Fig. 10: The user selects a profile to make active, column 9 lines 51-54.)**

identifying multiple stored preferences lists corresponding to the current user by searching a set of stored preferences lists, at least some of the preferences lists of the set of stored preferences lists corresponding to specific users, each of the preferences lists containing multiple entertainment programming channel identifiers; **(Fig. 18: The system displays lists 182, which correspond to the active users profile, column 12 lines 15-31.)**

providing a list display of the identified stored preference lists corresponding to the current user; **(Fig. 18)**

selecting one of the identified stored preferences lists by receiving a user choice of one of the multiple identified preferences lists of the list display; **(The user selects one of the lists 182, column 12 lines 32-39.)**

accessing the chosen preferences list. **(Fig. 19: The chosen list is displayed to the user, column 12 lines 32-39.)**

Consider **claim 2**, Ellis clearly teaches receiving a category identification from the current user; wherein identifying comprises searching the set of stored preferences lists also for the identified category; and wherein selecting one of the identified preferences lists includes the identified preferences lists for the identified category. **(Fig. 18: The displayed lists 182 correspond to categories and the user selects a category, column 12 lines 15-39.)**

Consider **claim 3**, Ellis clearly teaches identifying comprises searching the set of stored preferences lists also for generic preferences lists not corresponding to a specific user, and wherein selecting one of the identified preferences lists

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includes the identified generic preferences lists. **(If the user turns off the favorites always-on display mode the preferences lists displayed will correspond to the master profile, column 12 lines 4-8 and column 15 lines 4-7.)**

Consider **claim 4**, Ellis clearly teaches the stored preferences lists each correspond to at least one of a user and a category. **(Fig. 18: The lists correspond to the user and a category, column 12 lines 15-39.)**

Consider **claim 6**, Ellis clearly teaches receiving a new channel request; and determining a channel from the chosen preferences list to provide in response to the new channel request. **(When the user changes the channel the next channel in the preferences list is tuned, column 12 lines 40-62.)**

Consider **claim 10**, Ellis clearly teaches receiving an update request from a user; and updating the chosen preferences list in accordance with a received user input. **(The user may update the profile, column 10 lines 18-54.)**

Consider **claim 11**, Ellis clearly teaches the update request includes an indication of the particular preferences list that is to be updated. **(column 10 lines 18-54)**

Consider **claim 12**, Ellis clearly teaches the indication of the particular preferences list comprises a user selection from a list display. **(column 10 lines 18-54)**

Consider **claim 13**, Ellis clearly teaches if a reorder channel listings input is received, updating comprises changing the order of the channels in the list in accordance with the reorder channel listings input. **(column 14 lines 25-32)**

Consider **claim 14**, Ellis clearly teaches verifying that the identified user is authorized to access the lists and if the user is not authorized, then not updating the preferences list. **(Fig. 28: The user can require a PIN be used to access or edit the profile, column 14 line 60 to column 15 line 3.)**

Consider **claim 15**, see claim 1.

Consider **claim 16**, see claim 2.

Consider **claim 17**, see claim 3.

Consider **claim 18**, see claim 4.

Consider **claim 20**, see claim 1.

Consider **claim 21**, see claim 2.

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Consider **claim 22**, Ellis clearly teaches the user interface further comprises a remote control device with at least one of a particular category button, channel selection keys corresponding to a particular category, and an alphanumeric input. **(Fig. 1: Remote control 50 contains channel number keys, column 5 lines 47-53, and the ability to enter alphabetical characters, column 10 lines 58-63.)**

Consider **claim 23**, see claim 3.

Consider **claim 24**, see claim 6.

Consider **claim 25**, Ellis clearly teaches a channel selection controller to maintain a record of the current channel being provided to the user; and wherein the channel selector is further to compare the current channel being provided to the chosen preferences list, and if the current channel being provided is in the chosen preferences list, then to determine that the channel in the preferences list subsequent to the current channel being provided is the next channel. **(The system knows the current channel and when a channel change is requested the next channel in the list is tuned, column 12 lines 40-62.)**

Consider **claim 30**, see claim 10.

Consider **claim 31**, see claim 14.

Consider **claim 32**, see claims 1 and 22.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims **5, 7-9, 19, 26-29 and 33** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Ellis et al. (US Patent 7,185,355)** in view of **Stinebruner (US Patent 6,133,910)**.

Consider **claim 5**, Ellis clearly teaches choosing a preference list and accessing content via programming identifiers displayed in the list.

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However, Ellis does not explicitly teach the identifiers identifying particular communication paths for entertainment programming from any one of a wide variety of different transport media.

In an analogous art, Stinebruner, which discloses a system for receiving and displaying video content, clearly teaches identifiers identifying particular communication paths for entertainment programming from any one of a wide variety of different transport media. **(Fig. 1: Video signals are received via a plurality of sources 5, column 4 line 63 to column 5 line 18. Fig. 2: Virtual channel numbers are assigned to each programming channel and associated with source information, column 7 lines 3-15.)**

Therefore, at the time the invention was made, it would have been obvious to one with ordinary skill in the art to modify the system of Ellis by identifying particular communication paths for entertainment programming from any one of a wide variety of different transport media, as taught by Stinebruner, for the benefit of simplifying the tuning process when video content is received from multiple sources (see column 2 lines 26-39 Stinebruner).

Consider **claim 7**, Ellis combined with Stinebruner, as in claim 5, clearly teaches tuning a component of an entertainment system to the determined channel once the next channel is determined **(When the user changes the channel the next channel in the preferences list is tuned, column 12 lines 40-62 Ellis.)** by sending a message to a component controller indicating an appropriate device within the entertainment system that is a source for the determined channel, as well as an identifier of the determined channel. **(column 5 line 56 to column 6 line 14 Stinebruner)**

Consider **claim 8**, Ellis combined with Stinebruner, as in claim 5, clearly teaches the chosen preferences list includes information that identifies a component within the entertainment system to tune to the determined channel. **(Virtual channel numbers are assigned to each programming channel and associated with source information, column 7 lines 3-15 Stinebruner.)**

Consider **claim 9**, Ellis combined with Stinebruner, as in claim 5, clearly teaches accessing an electronic programming guide (EPG) database to identify a component for tuning to the determined channel. **(Virtual channel numbers are assigned to each programming channel and associated with source information, column 7 lines 3-15 Stinebruner.)**

Consider **claim 19**, see claim 8.

Consider **claim 26**, see claim 7.

Consider **claim 27**, see claim 7.

Consider **claim 28**, see claim 8.

Consider **claim 29**, see claim 9.
Consider **claim 33**, see claim 9.

(10) Response to Argument

In response to appellant's argument that the rejection of claims 1-14 under 35 USC 101 was presented for the first time in the final rejection, the examiner notes that this is incorrect. The rejection was presented in the Non-Final office action dated 06/19/2009.

In response to appellant's argument that the rejection of claims 1-14 under 35 USC 101 is improper because the method is tied to a data store and a display, the examiner respectfully disagrees. The method of choosing a preference list is not being performed by either the data store or the display and as such is not tied to another statutory category.

In response to appellant's argument (Section 1) that the single profiles of Ellis do not anticipate the multiple preferences lists for one user, the examiner respectfully disagrees. Appellant argues that the selection of a profile in the Ellis reference is being used to teach two claimed operations and this is incorrect. A thorough reading of the office actions will clearly show two separate operations are being discussed in the Ellis reference. Ellis shows the system "receiving a user identification for a current user" in figure 10. The user selects a profile to make active (col. 9 lines 51-54). The system then displays multiple lists to the user (figure 18). The user then "select[s] one of the identified stored preferences lists" (col. 12 lines 32-39). Clearly the user identification and list selection are separate steps in the Ellis reference.

In response to appellant's argument (Section 2) that Ellis does not disclose multiple preference lists but merely different arrangements of a single list, the examiner respectfully disagrees. Figure 18 of Ellis shows navigator menu 184 includes a plurality of program lists. Including as the appellant argues different rearrangements of a list, by time and by channel. However, Ellis also shows many other options including movies, sports, children, pay-per-view, special events, premium, DMX, adult, etc. These clearly represent different categories of content that the user may select. When a category is selected a list of content that fits that category is displayed to the user. Figure 19 shows a single example of a time arranged list being displayed but any type of category may obviously be presented in this manner.

In response to appellant's argument that Ellis does not disclose stored lists, the examiner respectfully disagrees. As previously described a user of the system of Ellis would select a profile to make active then receive a display of a plurality of lists. After activating the profile, stored lists (figure 18 movies, sports, children, etc.) are searched to identify the content that matches the profile (col. 12 lines 4-8). These lists are then presented for selection.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

This examiner's answer contains a new ground of rejection set forth in section **(9)** above. Accordingly, appellant must within **TWO MONTHS** from the date of this answer

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exercise one of the following two options to avoid *sua sponte* **dismissal of the appeal** as to the claims subject to the new ground of rejection:

(1) **Reopen prosecution.** Request that prosecution be reopened before the primary examiner by filing a reply under 37 CFR 1.111 with or without amendment, affidavit or other evidence. Any amendment, affidavit or other evidence must be relevant to the new grounds of rejection. A request that complies with 37 CFR 41.39(b)(1) will be entered and considered. Any request that prosecution be reopened will be treated as a request to withdraw the appeal.

(2) **Maintain appeal.** Request that the appeal be maintained by filing a reply brief as set forth in 37 CFR 41.41. Such a reply brief must address each new ground of rejection as set forth in 37 CFR 41.37(c)(1)(vii) and should be in compliance with the other requirements of 37 CFR 41.37(c). If a reply brief filed pursuant to 37 CFR 41.39(b)(2) is accompanied by any amendment, affidavit or other evidence, it shall be treated as a request that prosecution be reopened before the primary examiner under 37 CFR 41.39(b)(1).

Extensions of time under 37 CFR 1.136(a) are not applicable to the TWO MONTH time period set forth above. See 37 CFR 1.136(b) for extensions of time to reply for patent applications and 37 CFR 1.550(c) for extensions of time to reply for ex parte reexamination proceedings.

Respectfully submitted,

/John Schnurr/

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A Technology Center Director or designee must personally approve the new ground(s) of rejection set forth in section (9) above by signing below:

/Timothy P Callahan/

Director, Technology Center 2400

Conferees:

/John W. Miller/

Supervisory Patent Examiner, Art Unit 2421

/Christopher Kelley/

Supervisory Patent Examiner, Art Unit 2424